

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : FULTHEIM et al.

Serial No. : 10/828,465 Group Art Unit: 2128
Filed : April 21, 2004 Examiner: David Silver
For : CLUSTER BASED OPERATING SYSTEM-AGNOSTIC VIRTUAL
COMPUTING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. Introductory Comments

Claims 1-45 are pending in this application. Claims 1, 14 and 28 are independent claims. The pending claims are listed in an Amendment filed October 19, 2009.

In an Official Action dated July 16, 2010, all of the claims were finally rejected for obviousness. Claims 1-4, 9-16, 22-30, and 32-45 were rejected under 35 U.S.C. 103(a) over Okamoto (U.S. Patent 5,829,041) in view of the VMware Workstation User's Manual, while claims 5-8, 17-21 and 31 were rejected over Okamoto and VMware in view of Altman et al. (U.S. Patent Application Publication 2004/0054517). Appellant believes these rejections should be reversed.

The following documents in the file history of this application are relevant to the present appeal:

- A) Non-final rejection, issued May 18, 2009.
- B) Amendment in response to non-final rejection, filed October 19, 2009.
- C) Declaration under 37 CFR 1.132 by Dr. Joseph Landman and supporting exhibits, filed with the amendment of October 19, 2009.
- D) Declaration by under 37 CFR 1.132 by Boaz Yehuda, filed with the amendment of October 19, 2009.
- E) Non-final rejection, issued December 30, 2009.
- F) Remarks in response to non-final rejection, filed April 26, 2010.
- G) Declaration under 37 CFR 1.132 by Dr. Guy Tel-Zur, filed with the response of April 26, 2010.
- H) Final rejection, issued July 16, 2010.

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II. The Issue for Consideration in this Review – Objective Evidence of Non-obviousness

The Declarations by Landman and Yehuda (items C and D above) provide proof that the invention recited in the claims of the present patent application is objectively non-obvious on a number of grounds. Specifically, the Declarants explain that the claimed invention yields unexpected results and satisfies a long-felt need in the High-Power Computing (HPC) industry, and has also led to commercial success and imitation. Landman's Declaration on this point is supported by exhibits containing documentary evidence (see paragraphs 14-18 and Exhibits B-E). In the Official Action (item E) following the submission of these Declarations, however, the Examiner did not consider – and in fact did not even mention – the Declarations and the secondary considerations that they raised.

Appellant pointed out this lacuna in the response to this Official Action (item F), and the objective non-obviousness of the invention was again endorsed in the Declaration by Tel-Zur (item G). Yet in the Final Official Action (item H), the Examiner simply dismissed Appellant's evidence out of hand:

“15. Consideration was indeed given to the previously submitted secondary consideration but the Declaration was unpersuasive. Specifically, it pointed out similar issues as above, and has thus been addressed explicitly herewithin.”

The section “above” in the Examiner's remarks relates to Tel-Zur's explanation of why the references cited in the Official Action do not support a *prima facie* case of obviousness. This section says nothing about the long-felt need for the invention or any other secondary considerations. The Examiner stated no reason at all for his conclusion that the secondary considerations raised by the declarants were “unpersuasive.”

Putting aside the question of *prima facie* obviousness (which Appellant does not concede by any means), the Examiner has failed to relate in any way to the substance of the secondary considerations that Appellant introduced as objective evidence of non-obviousness. This strong objective evidence has thus stood unchallenged through two rounds of examination. On this basis alone, all the claims currently pending in this application should be allowed.

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III. Secondary Considerations Cannot be Disregarded

It is very clear that the Examiner has failed to meet the requirements of MPEP 716.01(B) with respect to the objective evidence of non-obviousness raised in the Declarations by Landman and Yehuda:

Consideration of evidence. Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action... Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient.

MPEP 716.01(a) continues:

OBJECTIVE EVIDENCE MUST BE CONSIDERED WHEN TIMELY PRESENT
Affidavits or declarations, when timely presented, containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness."

The Examiner has not commented on, and has barely even acknowledged, the Declarations by Landman and Yehuda, and certainly has not given an explanation to support his findings regarding the evidence of secondary considerations provided by these Declarations.

The rules stated in MPEP are supported by well-established case law. Most recently, the Court of Appeals for the Federal Circuit overturned a summary judgment by the district court for failure to consider objective evidence of non-obviousness in *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, Fed. Cir. _____ (August 18, 2010), page 11 (citations omitted):

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We hold that the district court erred by failing to consider Transocean's objective evidence of nonobviousness. Our case law is clear that this type of evidence "must be considered in evaluating the obviousness of a claimed invention".... While it is true that we have held in individual cases that objective evidence of nonobviousness did not overcome the strong *prima facie* case – this is a case-by-case determination.... To be clear, a district court must always consider any objective evidence of nonobviousness presented in a case... (page 11)

Although the Examiner in the present application appears to have taken the position that he may consider or disregard Appellant's objective evidence of non-obviousness at his option, this position is in outright contradiction to the dictates of MPEP and the case law.

IV. Conclusion

MPEP and the case law make clear that objective evidence of non-obviousness (secondary considerations) submitted by the applicant must be considered and given due weight by the Patent Office. In the present case, the Examiner has failed to meet this requirement. Proper consideration of the evidence that Appellant has submitted in the present case will lead to a clear conclusion that the claimed invention is non-obvious.

For the sake of brevity, Appellant has addressed only the issue of secondary considerations in this request for review, since this point by itself is sufficient to establish the patentability of the claims. It should in no way be understood, however, that Appellant concedes that the Examiner has made a *prima facie* case of obviousness. Appellant reserves the right to argue this point should the present case proceed to a full appeal.

In view of the above remarks, Appellant respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

Respectfully submitted,

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